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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,853	03/07/2000	Michael O'Doherty	584-1022	8975

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EXAMINER	
FLYNN, KIMBERLY D	
ART UNIT	PAPER NUMBER
2153	17

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/520,853	O'DOHERTY, MICHAEL	
	Examiner	Art Unit	
	Kimberly D Flynn	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) *16-19 and 27-33* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 20-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

1. This action is in response to an Amendment filed December 23,2003. Claims 1-33 are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 3 recites the limitation "the step of associating computer software code" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections – 35 U.S.C. 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 2, 5, 9, 10-15, and 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al.(6,446,070), in view of Beyda et al. (6,636,965), in further in view of Handley et al. (RFC 2543 – SIP: Session Initiation Protocol).

In considering claim 1 and 2, Arnold et al. discloses a method of transferring computer software code between a first and a second node in a communications network, comprising the steps of:

(i) while the system disclosed by Arnold discloses transferring computer code between a first and second node in a communications network, it does not specifically disclose storing computer software code in a message. Nonetheless, storing computer software in a message is well known as evidenced by Beyda. In similar art, Beyda discloses a system for embedding recipient specific comments in electronic messages using encryption wherein the encrypted comments may be an applet or a mini-program (see Beyda col. 4, lines 42-48);

(ii) sending the message and computer software code from the first client associated with the first node to the second client associated with the second node (server) (see col. 6, lines 4-31; Fig. 3, Client 302, Server 316); and

(iii) executing the computer software using the second node (see col. 6, lines 23-41).

Although Arnold et al. shows substantial features of the claimed invention, he fails to specifically disclose a method wherein each of the nodes comprises an SIP client, as well as the message comprising an SIP message. However, Handley et al., whose invention is the Internet standard for SIP, Session Initiation Protocol, discloses such nodes comprising an SIP client (see page 9, lines 17-19; page 11, lines 4-7), as well as an SIP message being sent from the client to the server, with the message associated with an option message body (see page 25, lines 21-33). Therefore, given the teachings of Handley et al., it would have been obvious for a person having ordinary skills in the art to modify Arnold et al. by employing SIP clients and servers, as well as associating SIP messages with computer software in order to utilizing the software in conjunction with the multimedia session conducted between the client and the server.

In considering claims 20 and 26, Arnold et al. discloses a communications network node, as well as a communications network comprising a plurality of communications network nodes (see Fig. 1, Network 100), with each node comprising:

a SIP client;

an input arranged to receive SIP messages (see col. 6, lines 4-31); and

a processor arranged to extract and execute computer software code from a received SIP message (see Fig. 2, CPU 205).

In considering claims 24 and 25, Arnold et al. discloses a computer program (type or class), stored on a computer readable medium (remote hardware via URL), arrange to control a communications network node, the node comprising a client and a processor, the computer program being arranged to control the node when executed on the processor such that when a SIP message is received by the SIP client, which contains computer software code, the software code is executed by the processor (see Fig. 2, CPU 205; col. 8, lines 1-31).

Additionally, Handley et al. discloses an SIP client (see page 9, lines 17-19; page 11, lines 4-7), and an input arranged to receive SIP messages received by the SIP server (see page 25, lines 21-33); as well as the execution of software code within an SIP message when that message are received by SIP client (see page 20, lines 18-23).

In considering claims 2 and 10, Beyda further discloses a method wherein the computer software code is added to the message (see Beyda col. 4, lines 42-48).

In considering claim 5, Arnold et al. discloses a method wherein the computer software code comprises Java byte code (see col. 3, lines 47-51).

In considering claim 6, Beyda further discloses a method wherein the computer software code comprises one or more Java Applets (see Beyda col. 4, lines 42-48);

In considering claims 9 and 21, Arnold et al. discloses a method wherein the second node comprises a Java virtual machine (see col. 3, lines 47-51).

In considering claims 11 and 23, Handley et al. discloses a method which further comprises adding an indicator to the header of the SDIP message in order to indicate the presence of the computer software code and arranging the second SIP client to recognize the indicator (content-type) (see page 85, lines 4-9).

In considering claim 12, Handley et al. discloses a method which further comprises the step of proceeding with any SIP process related to the SIP message (via general header) (see page 25, lines 22-40; page 26, lines 1-11; page 27, Table 3).

In considering claim 13, Although Arnold et al. and Handley et al. show substantial features of the claimed invention, they fail to a to specifically disclose a method wherein the second SIP client is arranged such that on receipt of a SIP message containing such an indicator, the computer software code stored in the SIP message is executed by the second node before that second node carries out any other process related to the SIP message. Nonetheless, this execution of the computer software would have been an obvious modification to the SIP message containing an indicator for the message body/computer software in its header. It would have been obvious for a person having ordinary skills in the art to modify Arnold et al. and Handley et al. by employing a method wherein the second SIP client is arranged such that on receipt of a SIP message containing such an indicator, the computer software code associated with the SIP message is executed by the second node before that second node carries out any other process

related to the SIP message in order to provide a level of priority for the message body/computer software over other SIP-specified processes, thus providing for the quick receipt of urgent computer software.

6. Claims 14, 15, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al. and Handley et al. as applied to claim 1, and in further view of Gampper et al. (6,003,082).

In considering claims 14, 15, and 22, although Arnold et al. and Handley et al. show substantial features of the claimed invention, they fail to disclose a method wherein the computer software being arranged to interact with the second SIP client via a specified API. However, Byttner et al. et al., whose invention is a proposal for a Java extension API for SIP servers, discloses such a specified API (see page 3, lines 15-20, lines 35-46). Therefore, given the teachings of Byttner et al., it would have been obvious for a person having ordinary skills in the art to modify Arnold et al. and Handley et al. by arranging computer software to interact with the second SIP client via a specified API in order to the services needed to transport data across a network.

7. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al. and Handley et al. as applied to claim 1, and in further view of Gampper et al.(6,003,082).

In considering claims 3 and 4, although Arnold et al. and Handley et al. show substantial features of the claimed invention, they fail to disclose a method wherein the step of associating computer software code with the SIP message comprises adding a URL to the SIP message which indicates where the computer software is stored. However, Gampper et al., whose invention is the use of a server to selectively filter and cache internet access requests from the

terminals attached to the server, discloses such a URL, added to a message, that indicates where computer software code is stored (see col. 2, lines 32-43). Therefore, given the teachings of Gampper et al., it would have been obvious for a person having ordinary skills in the art to modify Arnold et al. and Handley et al. by adding a URL to the SIP message which indicates where the computer software is stored in order to reduce the byte overhead of the message body containing the computer software code.

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al. and Handley et al. as applied to claim 1, and in further view of Lavian et al. (6,175,868).

In considering claims 7 and 8, although Arnold et al. and Handley et al. show substantial features of the claimed invention, they fail to disclose a method wherein the computer software code comprises one or more Java mobile agents. However, Lavian et al., whose invention is a method and apparatus for automatically configuring a network switch having external network data ports, a processor, and memory, discloses such a computer software code comprising one or more Java mobile agents (see col. 6, lines 31-41). Therefore, given the teachings of Lavian et al., it would have been obvious for a person having ordinary skills in the art to modify Arnold et al. and Handley et al. by providing computer software code that comprises one or more Java mobile agents in order to provide compatibility with various Java-based environments, including mobile/wireless environments.

Response to Arguments

9. Applicant's arguments, filed December 23, 2003 with respect to the rejection(s)of claim(s) 1-15 and 20-26 have been fully considered and are persuasive. Therefore, the rejection

has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Beyda.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly D Flynn
Examiner
Art Unit 2153

KDF

FRANTZ B. JEAN
PRIMARY EXAMINER